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09/831,658	05/11/2001	Bernhard Riepler	RIEPLER (PCT)	7006

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EXAMINER

FISCHMANN, BRYAN R

ART UNIT

PAPER NUMBER

3618

DATE MAILED: 09/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/831,658

Applicant(s)

RIEPLER, BERNHARD

Examiner

Bryan Fischmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 30-57 is/are pending in the application.
- 4a) Of the above claim(s) 30-50, 56 and 57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### ***Acknowledgments***

1. The Preliminary Amendment (paper 4) filed 5/11/2001 has been entered in part. This is due to the fact that the amendment (paper 4) contained substitute pages of the specification. These substitute pages of the specification do not conform to 37 USC 1.121, as there is no "mark-up" version to indicate what changes have been made. Also, "substitute pages" are not allowed per 37 USC 1.121. Per 37 CFR 1.121, changes to the specification may only be made by paragraph, sections of the specification, (Background, Detailed Description, etc), or a substitute specification may be submitted. However, substitution by "page", as Applicant appears to have done in paper 4 is not allowed.

Accordingly, "substitute pages" 1-6e have not been incorporated and objections to the specification are based on the "as filed" specification.

The Species Election (paper 6) filed 7-21-2003 has been entered.

### ***Election/Restriction***

2. Paper 5 required a species election between four species. In paper 6, Applicant elected to prosecute species IIII (Figures 7 and 8). Since the Applicant did not state whether the election was with, or without traverse, the election is being treated as being without traverse.

Also, in paper 6, Applicant stated that claims 51-57 "cover" the elected species. However, it is noted that claims 56 and 57 are dependant upon claim 30, which Applicant did not indicate was drawn to the elected species in paper 6. Accordingly,

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claims 56 and 57, as well as claims 30-50, are withdrawn, as being drawn toward a non-elected species. Note that claims 1-29 have been canceled.

3. An action on the merits of elected species IIII, claims 51-55 follow.

### ***Change of Examiner***

4. The Instant Application has been transferred from the docket of Patent Examiner Lori Amerson to the docket of Patent Examiner Bryan Fischmann. The Instant Application was originally incorrectly classified in Class 482. The Instant Application is now classified in Class 280, Land Vehicles, which includes cross-country skis, as well as roller skates, which is best understood to correspond to the Instant Invention.

### ***Specification***

5. The abstract of the disclosure is objected to because of the following:

A) The words "Use Fig. 1 for abstract" appear on the abstract page.

6. The originally filed disclosure is objected to because of the following:

Note that the disclosure is considered to be replete with objectionable matter.

Therefore, a comprehensive listing of all objectionable matter cannot be guaranteed.

Applicant is advised to thoroughly review the disclosure for all objectionable matter.

A) Pages 1-6 are replete with references to claims 1-29, which have been canceled. Note that the disclosure should not make reference to the claims, and in particular to claims that have been canceled, as the claims are subject to cancellation, amendments, or renumbering.

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B) The first sentence of the specification does not indicate whether the international application which benefit is being claimed was published under PCT article 21(2) in English. See 37 CFR 1.78(a)(2) and Section 202.01 of the MPEP.

C) Section headings, such as "Background", "Brief Description of the Drawings", "Detailed Description of the Invention", etc., are not present in the disclosure.

D) Though not strictly objectionable, it has been noted that the British Variation spelling of certain words appear in the disclosure. See for example, the word "centre" in the last paragraph of page 11.

E) On the first line of page 23, it is believed that "Figs. 7 and 8" should be recited in place in "Figs. 5 and 6".

F) The "movements" of the "shoe" described in the first several lines of page 23 are considered somewhat unclear. For example, it is not entirely clear how that shoe pivots about both axis 71 and 46 and how the shoe also moves in the direction of arrow 9.

G) In the second paragraph of page 23, it is not clear why the rolling path being referred to is reference number 27, as opposed to reference number 75, since Figures 7 and 8 are being explained on page 23, not Figure 2, which illustrates reference number 27.

H) On the third line of page 24 there should be a space between the words "cross" and "country".

I) The meaning of the last few paragraphs on page 24, and in particular the last paragraph, is considered unclear.

***Information Disclosure Statement***

7. The Information Disclosure Statement (paper 3.5) has been initialed in part by the old Examiner (Lori Amerson). The new Examiner, Bryan Fischmann, has also initialed-off on all cited references.

***Drawings***

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the tread surface pivotable to a position closer to a position closer to the sports device as recited in claim 51 must be shown or the feature canceled from the claim. No new matter should be entered.

Note that claim 51, which corresponds to Figures 7 and 8 does not illustrate the tread surface pivoting relative to the sports device. This illustration of this pivoting is considered necessary, as the specification, particularly page 23, leaves unclear how the species of Figures 7 and 8 is allowed to pivot relative to the sports device. For example, which parts are attached to the treat surface and attached sports shoe 7 and which parts are attached to the sports device 2. Also, what parts "pivot" about pivot axes 46 and 71. How is pivoting possible about two separate axes (46 and 71)? Also, does lever 67 compress during pivoting? The illustration of Figures 7 and 8 would appear to leave this unclear, although the cross-hatching used for lever 67 appears to correspond to a compressible material.

***Claim Objections***

9. Claims 51-55 are objected to because of the following:

Note that the claims are considered to be replete with objectionable subject matter. Due to this, the Examiner cannot guarantee that what follows is a comprehensive listing of all objectionable matter. Applicant is advised to thoroughly review the claims for all instances of objectionable matter.

A) The recitation of "...in at least one part region..." in line 5 of claim 51 is objected to, as being awkwardly worded.

B) Lines 4-7 of claim 51 are considered to be awkwardly worded and somewhat unclear.

C) The recitation of "...to a position closer to the sports device...", in line 6 of claim 51 is objected to, as it has not yet been established in the claim that the tread surface is "away" from the sports device.

D) The use of the word "means" in lines 7, 10 and 16 of claim 51 is objected to, as the word "means" in a claim is generally associated with "means plus function" under 35 USC 112 6<sup>th</sup> paragraph. Since it is not believed that this is the intent of Applicant, it is requested that Applicant refrain from using the word "means" in the claims, unless 35 USC 112 6<sup>th</sup> paragraph is being invoked.

E) The recitation of "...the tread surface (5) is supported in a gliding action on the curved rolling surface..." toward the end of claim 51 is considered to be awkward and somewhat unclear.

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F) The description of reference number 22 as a "rolling body" in claim 51 is objected to, as best understood, reference number 22 is fixed to the sports device, and therefore does not "roll".

***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 51-55 are rejected under 35 USC 101, as claim 51 positively recites "the foot" in line 4. A "foot" is non-statutory subject matter.

To overcome this rejection, the Applicant should only mention a "foot" within functional language, if mentioned at all.

***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 51-55 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention.

Note: The claims are considered replete with unclear matter. Due to this, a comprehensive listing of all instances of unclear matter cannot be guaranteed. Applicant is advised to review the claims for all instances of unclear matter.



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A) The recitation of "...a rolling body (22) with an arcuately curved rolling path..." in claim 51 is considered unclear. As best understood, reference number 22 is fixed to the sports device 2 and therefore would not have an "arcuately curved rolling path".

B) Claim 51 recites the limitation "the hinge mechanisms" in the last lines of the claim. There is insufficient antecedent basis for this limitation in the claim.

C) Claim 52 recites the limitation "the initial or rest position" in the first lines of the claim. There is insufficient antecedent basis for this limitation in the claim.

D) The last lines of claim 55 are considered unclear.

### ***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 51-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Girard, US Patent 6,017,050.

Girard teaches a pivotable binding system for mounting between a sports device and a tread surface (sole of boot 2), in which the tread surface is capable of being pivoted about an axis (4 or 5) almost parallel with an ankle joint of a user's foot and is displaceable toward the sports device (Figure 1) and having a binding element joined to the sports device, the binding element being provided with a lever (15), which is joined

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to the tread surface in a first end region by a hinge mechanism (5), characterized in that the tread surface rests on a rolling body (11) and the lever is provided in a second end region another hinge mechanism (17) joined to the rolling body.

Regarding the recitation of "energy storage mechanism" in claim 53, see reference number 19 of Girard.

Regarding claims 54 and 55, see Figure 3.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- A) Spitaler, et al – teaches cross-country ski binding
- B) Hansen – teaches snowboard binding
- C) Allinger, et al – teaches double hinged skate
- D) Hauglin – teaches cross-country ski binding
- E) German patent 3406439 – teaches cross-country ski binding
- F) European Patent 194633 – teaches cross-country ski binding

17. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (703) 306-5955. The examiner can normally be reached on Monday through Friday from 7:30 to 4:00.

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If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson, can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

*Bryan Fischmann 8-25-3*  
**BRYAN FISCHMANN**  
**PATENT EXAMINER**